

## **REMARKS**

### **Status of the Claims**

Claims 1-3, 7, 8 and 30-41 are pending in the application and are the subject of the current Restriction/Election requirement. Applicants respectfully request that claims 1, 3 and 30 be amended, that claim 2 be canceled, and that claims 34-41 be withdrawn from consideration at this time, as indicated above.

Claims 1, 3 and 30 have been amended herein in response to the Examiner's restriction/election requirement, thereby electing to have the Examiner move forward examining the claims drawn to a composition comprising FGF-18 protein. Claim 3 also has been amended to elect the species of the FGF-18 protein in combination with the target gene protein Shh.

Applicants assert that the claims as amended comply with 37 C.F.R. §1.116 such that the claims are fully supported in the application as originally filed and they contain no new matter.

### **Restrictions and Election**

The Examiner requires restriction of the claims, so that Applicant must choose a single invention from the following eight distinct groups:

- I. Claims 1-3 and 30-33, drawn to a composition comprising FGF-18.
- II. Claims 1 and 30-33, drawn to a composition comprising Shh.
- III. Claims 1 and 30-33, drawn to a composition comprising  $\beta$ -catenin.
- IV. Claims 1 and 30-33, drawn to a composition comprising Wnt protein.
- V. Claims 7, 8 and 34-41, drawn to a nucleic acid molecule encoding FGF-18.
- VI. Claims 7, 34-37 and 39, drawn to a nucleic acid molecule encoding Shh.
- VII. Claims 7, 34-37 and 39, drawn to a nucleic acid molecule encoding  $\beta$ -catenin.
- VIII. Claims 7, 34-37 and 39, drawn to a nucleic acid molecule encoding Wnt protein.

Applicant elects for further prosecution the claims of Group I, Claims 1, 3 and 30-33, drawn to a composition comprising FGF-18. In addition, the Examiner requires Applicant to elect a single species to which the claims shall be restricted if no generic claim is finally held to

be allowable (claims 3 and 41 being generic). As requested by the Examiner, Applicant elects the species of FGF-18 in combination with Shh, as noted in currently amended claim 3.

However, Applicant traverses the Restrictions/Election requirement and asserts that, although FGF-18, Shh,  $\beta$ -catenin, Wnt proteins and nucleic acid molecules encoding the same are all known in the prior art, the mere knowledge of the amino acid makeup and DNA sequences of these entities does not anticipate Applicant's discovery of their cartilage-forming properties. Rather, Applicant asserts unity of invention exists because, prior to the present invention, it was not known that FGF-18, Shh protein,  $\beta$ -catenin,  $\beta$ -catenin protein, and the Wnt family of proteins that stimulate  $\beta$ -catenin were all related in their cartilage-forming properties. (See paragraphs [0017]-[0019] of application).

### **CONCLUSION**

Applicants believe that each point raised in the current Office Action has been addressed, and in light of the amended claims respectfully request the Examiner to reconsider this restriction requirement. The Examiner is invited to contact the undersigned directly at 513-229-0383, ext. 105 with any questions or remaining issues regarding the pending claims.

Respectfully submitted,  
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